

REMARKS

In response to the Office Action mailed March 24, 2006, Applicant respectfully requests reconsideration. Claims 1, 2, 4-15, 17-19, and 21-32 are currently pending in this application and claims 1, 15, 27, and 29 are amended herein. Each of the rejections set forth in the Office Action has been carefully considered and is addressed below. The application as presented is believed to be in condition for allowance.

Initially, Applicant thanks Examiner Abel-Jalil for the courtesies extended during the telephone interview of May 9, 2006 in which the undersigned and Scott J. Gerwin (Reg. No. 57,866) participated. The substance of the interview is summarized herein.

Allowable Subject Matter

The Office Action indicates that all pending claims would be allowable if rewritten or amended to overcome the claim objections and rejections under 35 U.S.C. §101 set forth in the Office Action. Applicant believes that each of the claim objections and §101 rejections has been addressed. Thus, Applicant respectfully requests the issuance of a notice of allowance.

Claim Objections

The Office Action objects to the phrase “can be used” in claim 1, asserting that is an optional limitation. The Office Action also objects to the phrases “using the ELVID to assure” in claim 15 and “usable to access” in claims 15, 26, 29, 31, and 32, asserting that these phrases recite an intended use and do not carry patentable weight.

During the telephone interview, Applicant explained that the above-recited phrases are directed to a characteristic of an ELVID and not an intended use. For example, claim 1, as pending prior to the amendments made herein, recited an ELVID that can be used to access the one of the plurality of logical volumes on at least two of the plurality of storage systems. Applicant pointed out that the capability to access a logical volume on at least two storage systems is a characteristic of an ELVID, not an intended use for the logical volume. The Examiner indicated that if the phrase “can be used” were changed to “is usable” the objection would be withdrawn. Claim 1 has been so amended. During the telephone interview, the Examiner reconsidered the objections to the phrase

“usable to access” in claims 15, 26, 29, 31, and 32 and indicated that these would also be withdrawn.

The Office Action also objects to claim 32, asserting that it is a single element means claim. Applicant respectfully disagrees. During the telephone interview Applicant explained that claim 32 is not a single element means claim as it recites element in addition to the “means for verifying.” Indeed, the Federal Circuit has held that a single element means claim is “a claim which recites merely one means plus a statement of function and nothing else.” *In re Hyatt*, 708 F.2d 712, 713-14 (Fed. Cir. 1983). Claim 32 does not meet this standard, as it does not recite only a means element and nothing else. Rather, claim 32 recites “a host computer,” “a plurality of storage systems,” and “means for verifying.” Thus, as claim 32 is not a single element means claim, it is respectfully requested that the rejection of claim 32 be withdrawn.

Rejections Under 35 U.S.C. §101

The Office Action rejects claims 1 and 15 under 35 U.S.C. §101, asserting that these claims are not limited to a practical application because the use of a computer has not been indicated. During the telephone interview, Applicant asked the Examiner whether amending claims 1 and 15 to recite “a computer-implemented method” would overcome this rejection and the Examiner indicated that such amendments would overcome the rejection. Claims 1 and 15 have been so amended.

The Office Action also rejects claims 26, 27, and 29-32 as being directed to non-statutory subject matter. During the telephone interview Applicant pointed out that each of these claims is either a system or apparatus claim and meets the requirements of 35 U.S.C. §101. The Examiner indicated that the rejection of these claims under 35 U.S.C. §101 would be withdrawn.

The Office Action also rejects claims 31 and 32, asserting that these claims are not limited to a practical application because the use of a computer system has not been indicated. During the telephone interview, Applicant pointed out that claims 31 and 32 are system claims directed to computer systems and therefore are directed to statutory subject matter under §101. The Examiner agreed and indicated that the rejection of these claims would be withdrawn.

The Office Action also rejects claims 27 and 29 under 35 U.S.C. §101 asserting that the phrase “a storage system for” in the preamble of each of these claims recites an intended use and that limitations following the phrase “for” do not carry patentable weight. The Office Action also asserts that, in claim 27, the phrases “an input for receiving,” “a storage medium to store” should “contain positive recitation such as ‘is’ or ‘that.’” The Office Action further asserts that “claim 29 have [*sic*] the same deficiency.”

During the telephone interview, Applicant explained that the claims were written that way because they were designed to be infringed by storage systems having the recited capability, irrespective of whether the system was yet operating. Applicant asked if this goal could be achieved and the Examiner’s concern addressed by removing the phrase “for” from the preambles of claims 27 and 29. The Examiner indicated that she believed such an amendment would overcome the rejection. The preambles of claims 27 and 29 have been to recite, “a storage system usable in enterprise.” Applicant believes that these claims meet the requirements of the §101.

In view of the foregoing, it is respectfully requested that the rejections under 35 U.S.C. §101 be withdrawn.

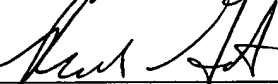
CONCLUSION

In view of the foregoing amendments and remarks, the application should now be in condition for allowance. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Dated:

Respectfully submitted,

By 

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